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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209778
Party	Defendant Catamaran Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>SHIPCOM WIRELESS, INC.,</b>	)	
	)	
<b>Opposer,</b>	)	<b>Opposition No. 91209777</b>
	)	<b>("Parent")</b>
<b>v.</b>	)	Opposition No. 91209778
	)	Opposition No. 91209779
<b>CATAMARAN, INC.,</b>	)	Opposition No. 91209780
	)	
<b>Applicant.</b>	)	

**ANSWER TO NOTICE OF OPPOSITION**

Catamaran Inc. ("Applicant"), by and through its undersigned counsel, Ungaretti & Harris LLP, answers the Notice of Opposition filed by Shipcom Wireless, Inc. ("Opposer") against Applicant Serial No. 85/654,697 as follows:

1. Opposer is a leading developer of supply-chain execution software designed for use in enterprise mobility markets. It provides server-based software solutions that integrate enterprise systems and capture, aggregate, filter, and route data from mobile devices to enterprise applications. Opposer's software solutions are used by numerous businesses across multiple industry sectors, including but not limited to oil, gas, energy, utilities, life sciences, pharma, medical instruments, manufacturing, defense, and transportation sectors. As a result of the versatility of Opposer's integrated software solutions, Opposer has developed a strong, diverse consumer base. Opposer currently services large and small businesses throughout the United States, Middle East, Asia, Africa, Australia, and other regions. Many of Opposer's customers are Fortune 500 companies in the United States.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Notice of Opposition and, therefore, denies those allegations.

2. Opposer has developed specialized identification and tracking software solutions for healthcare providers. Opposer's software enables multiple technologies to integrate real time data gathered across disparate hospital infrastructures with enterprise systems, allowing mobility and efficiency within hospitals' operational and clinical settings. A member of the Healthcare Information and Management Systems Society (HIMSS), Opposer devotes considerable resources to optimizing its software solutions within the healthcare industry. Opposer

participates in the annual HIMSS conference, where professionals from all healthcare sectors, e.g. governmental, hospital, and non-profit organizations, meet to discuss and share effective practices in information technology and management systems. Opposer is also partnered with key system integrators and service providers in the healthcare industry, such as SAIC, Inc., VetFed Resources, Inc., and ICS-Nett, Inc.

**ANSWER:** Applicant is without knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 2 of the Notice of Opposition and, therefore, denies those allegations.

3. Since at least as early as April 17, 2001, and substantially prior to Applicant's filing date for U.S. Application Serial No. 85/654,697, Opposer has continuously offered and promoted the CATAMARAN mark in connection with Opposer's integrated software solutions. The CATAMARAN product is a server-based software platform that integrates information collected from mobile devices, such as RFID readers and barcode scanners, directly with enterprise systems. The CATAMARAN platform features a suite of over 100 developmental tools and applications, which enable entities easily and quickly to configure the CATAMARAN software to their specific needs. Through continuous use and promotion of its CATAMARAN software, Opposer has acquired common law rights in the CATAMARAN mark.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Notice of Opposition and, therefore, denies those allegations.

4. Opposer owns U.S. Registration No. 2,576,219 for CATAMARAN for "software i) enabling interface between enterprise applications and wireless access by mobile devices and ii) integrating enterprise applications" in International Class 9. The application to register the CATAMARAN mark as shown in Registration No. 2,576,219 was filed on October 18, 2001, prior to Applicant's filing date for U.S. Application Serial No. 85/654,697. Attached hereto as Exhibit A is a true and correct copy of a printout from the TESS electronic database of the U.S. Patent and Trademark Office ("USPTO"), showing the current status and title of Registration No. 2,576,219. The Section 15 Affidavit was acknowledged on June 23, 2008, rendering Registration No. 2,576,219 incontestable.

**ANSWER:** Applicant admits that the United States Patent and Trademark Office online database lists Opposer as the owner of U.S. Registration No. 2,576,219 for CATAMARAN, registered June 4, 2002, from an Application filed on October 18, 2001, prior to the filing date of Applicant's Application Serial No. 85/654,697. Applicant further admits that Exhibit A purports

to be a true and correct copy of a printout from the TESS electronic database of the USPTO, alleging to show the current status and title of Registration No. 2,576,219. Applicant denies any remaining allegations contained in Paragraph 4 of the Notice of Opposition.

5. Opposer owns the goodwill and reputation of the goods connected with and symbolized by the CATAMARAN mark. Opposer regularly exhibits its CATAMARAN software at trade shows and conventions. In 2003, Opposer partnered with Hewlett Packard Co. to present Opposer's CATAMARAN software at the EPC Technology Exposition in Springdale, Arkansas. In 2004, Opposer's CATAMARAN software was used by Bell Canada Enterprises, a sponsor of the Olympic Games, to integrate components of a user-interactive, RFID-controlled demonstration on display in a 1,000-square-foot pavilion. As a result of extensive advertising, promotion and sales of Opposer's CATAMARAN software, Opposer has built up highly valuable goodwill in Opposer's CATAMARAN mark and said goodwill has become closely and uniquely identified and associated with Opposer and Opposer's goods.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Notice of Opposition and, therefore, denies those allegations.

6. Opposer's CATAMARAN products are particularly well known in the healthcare field. Opposer provides its CATAMARAN software directly to hospitals and pharmaceutical companies. In 2008, Opposer was selected by the U.S. Air Force Surgeon General's Office to implement Opposer's integrated software solutions at Keesler Medical Center, one of the largest medical centers in the Air Force. Opposer has continued to provide IT guidelines for the management of mobile medical equipment throughout the Air Force Medical Services.

**ANSWER:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice of Opposition and, therefore, denies those allegations.

7. On June 18, 2012, Applicant, a Texas corporation located at 2441 Warrenville Road, Lisle, Illinois 60532, filed Application Serial No. 85/654,697 in International Classes 9, 35, 36, and 44 for the design mark C CATAMARAN on an intent-to-use basis. The application was published in the *Official Gazette* on November 20, 2012.

**ANSWER:** Applicant admits the allegations contained in Paragraph 7 of the Notice of Opposition.

8. By the application herein opposed, Applicant seeks to register the design mark C CATAMARAN for, *inter alia*, “computer software for database integration in the area of drug information and pharmaceutical formulary management” in International Class 9 and “pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; specialty mail order pharmacy services; distributorship services in the field of special purpose pharmaceuticals; retail pharmacy services” in International Class 35.

**ANSWER:** Applicant admits the allegations contained in Paragraph 8 of the Notice of Opposition.

#### **LIKELIHOOD OF CONFUSION**

9. The primary distinctive element of Applicant’s proposed C CATAMARAN and design mark is identical to Opposer’s registered CATAMARAN mark—the term CATAMARAN is the dominant element of both marks, making Applicant’s and Opposer’s respective marks confusingly similar in appearance, sound, meaning, and commercial impression.

**ANSWER:** Applicant denies the allegations set forth in Paragraph 9 of the Notice of Opposition.

10. The Class 9 goods covered by Application Serial No. 85/654,697 are competitive, complementary, and/or closely related to the integrated software solutions offered under Opposer’s CATAMARAN mark and covered by Opposer’s prior registration. Applicant intends to offer “computer software for database integration,” which overlaps with software integrating enterprise applications already offered by Opposer under the CATAMARAN mark. Applicant’s proposed software may also be used in conjunction with Opposer’s CATAMARAN software to integrate wirelessly enterprise applications with mobile devices.

**ANSWER:** Applicant denies the allegations set forth in Paragraph 10 of the Notice of Opposition.

11. The Class 35 services covered by Application Serial No. 85/654,697 are competitive, complementary, and/or closely related to the integrated software solutions offered under Opposer’s CATAMARAN mark and covered by Opposer’s prior registration. Applicant’s services may rely on or be offered in conjunction with Applicant’s computer software in Class 9, which overlaps with software integrating enterprise applications already offered by Opposer under the CATAMARAN mark. Therefore, Applicant’s proposed services may be used together with Opposer’s CATAMARAN software to integrate wirelessly enterprise applications with mobile devices.

**ANSWER:** Applicant denies the allegations set forth in Paragraph 11 of the Notice of Opposition.

12. Opposer is informed, believes and on that basis alleges that consumers of the Class 9 goods and Class 35 services identified in Application Serial No. 85/654,697 are likely to consist of many of the same consumers within the healthcare industry who are familiar with Opposer's CATAMARAN software. Applicant's proposed software integrates drug and pharmaceutical formulary information. Opposer's CATAMARAN software integrates data collected from mobile equipment, which may include drug and pharmaceutical information, with enterprise applications operated by hospitals and pharmaceutical companies. The software provided by both Applicant and Opposer is likely to be used by professionals within the same industry.

**ANSWER:** Applicant admits that its proposed software integrates drug and pharmaceutical formulary information. Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations contained in Paragraph 12 of the Notice of Opposition and, therefore, denies those allegations.

13. Opposer is informed, believes and on that basis alleges that Applicant will offer and distribute its goods and services through channels of trade that will overlap with those used by Opposer to offer and distribute Opposer's CATAMARAN software. Opposer promotes the CATAMARAN mark in various professional settings as a member of the HIMSS. Opposer is informed and believes that Applicant is also a member of HIMSS, and on that basis alleges that consumers of Applicant's and Opposer's software are likely to encounter Applicant's and Opposer's respective marks through similar channels.

**ANSWER:** Applicant denies that it is a member of HIMSS. Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations contained in Paragraph 13 of the Notice of Opposition and, therefore, denies those allegations.

14. In view of the fact that the primary distinctive element of Applicant's C CATAMARAN and design mark is identical to Opposer's CATAMARAN mark; that Applicant's and Opposer's goods and/or services are competitive, complementary, and/or closely related; and that the customers and trade channels for Applicant's and Opposer's goods and/or services will be the same or overlapping, Applicant's C CATAMARAN and design mark is likely to cause confusion with Opposer's CATAMARAN mark, or to cause mistake, or to deceive as to the origin, source, or sponsor of Applicant's goods and services. Opposer would thereby be injured by Applicant's intended use and registration of mark in Application Serial No. 85/654,697 in International Classes 9 and 35.

**ANSWER:** Applicant denies the allegations contained in Paragraph 14 of the Notice of Opposition.

### **AFFIRMATIVE DEFENSES**

1. Opposer has failed to state a claim upon which relief can be granted.
2. Opposer's claim of likelihood of confusion is barred by *Morehouse Mfg. Co.*, 160 U.S.P.Q. 715 (C.C.P.A. 1969).

WHEREFORE, Applicant, Catamaran Inc., prays that this Opposition be dismissed with prejudice and that its application be allowed.

Dated: August 7, 2013

Respectfully submitted,

/s/Bryan P. Sugar  
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*Attorneys for Applicant Catamaran Inc.*

**CERTIFICATE OF SERVICE**

I, Bryan P. Sugar, hereby certify that a true and correct copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** has been mailed this 7<sup>th</sup> day of August, 2013, by first-class mail, postage pre-paid, to:

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